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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/086,000 | 02/28/2002 | William Hopkins | Mo6835/PS-1096 | 1094 |
| 157 | 7590 | 05/12/2004 | EXAMINER | |
| BAYER POLYMERS LLC 100 BAYER ROAD PITTSBURGH, PA 15205 | | | WYROZEBSKI LEE, KATARZYNA I | |
| | | | ART UNIT | PAPER NUMBER |

1714

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|---|--|
| Office Action Summary | Application No. 10/086,000 | Applicant(s) HOPKINS, WILLIAM | |
| | Examiner Katarzyna Wyrozebski | Art Unit 1714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1714

In view of applicant's amendment submitted on 3/25/2004 following final office action is necessitated.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 4-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Newly amended independent claims contain negative limitation "does not include carbon black". The specification of the present invention according to *In re Grasseli* should contain explicit support for the negative limitation. In fact applicant's disclosure teaches that the carbon black can be utilized (page 2, line 27-29) in mixture with mineral filler. The same teaching was found on page 17, lines 7-9 of the present invention.

In view of the above the prior art of record as applied against present claims is not overcome and it is incorporated here by reference.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 4-7, 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by MROCZKOWSKI (US 5,162,409).

The discussion of the disclosure of the prior art of MROCZKOWSKI from paragraph 2 of the first office action dated 11/19/2003 on the merits is incorporated here by reference.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over MROCZKOWSKI (US 5,162,409) in view of SANDSTROM (US 5,087,668).

The discussion of the disclosure of the prior art of MROCZKOWSKI and SANDSTROM from paragraph 5 of the first office action dated 11/19/2003 on the merits is incorporated here by reference.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over MROCZKOWSKI (US 5,162,409) in view of JALICS (US 5,708,053).

The discussion of the disclosure of the prior art of MROCZKOWSKI and JALICS from paragraph 6 of the first office action dated 11/19/2003 on the merits is incorporated here by reference.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over MROCZKOWSKI (US 5,162,409) in view of KAUSH (US 5,488,092).

The discussion of the disclosure of the prior art of MROCZKOWSKI and KAUSH from paragraph 7 of the first office action dated 11/19/2003 on the merits is incorporated here by reference

9. In the response dated 3/25/2004 the applicants argued following:

a) The prior art of MROCZKOWSKI does not teach use of natural rubber and bromobutyl rubber, refereeing to Table 1 of Mroczkowski.

Art Unit: 1714

With respect to the above argument, although the first office action referred to the Table 1, it did so for the amount of the butyl rubber. Natural rubber is taught in the specification of MROCZKOWSKI as it was also stated in the first office action on the merits. The examiner would like to point out that for a rejection an entire disclosure of the prior art has to be considered. The specification MROCZKOWSKI clearly states that the bromobutyl rubber is utilized in conjunction with natural rubber or synthetic rubber. The combination is therefore clearly envisaged by the prior art of MROCZKOWSKI.

b) The prior art of SADSTROM does not overcome the deficiencies of MROCZKOWSKI.

At this point MROCZKOWSKI has no clear deficiencies when compared to claims of the present invention.

c) SANDSTROM does not teach or suggest elastomeric composition comprising natural rubber and halobutyl rubber.

With respect to the above argument, the prior art of SANDSTROM was applied to dependent claims reciting limitation of shoe sole and stepwise addition of components of the composition. As it is shown in the prior art of SANDSTROM rubber composition that is utilized in formation of the tire tread can also be utilized in making of shoe soles. Therefore the obviousness statement was in making shoe soles out of the composition of MROCZKOWSKI.

d) The prior art of SANDSTROM does not teach the process of the present invention.

Art Unit: 1714

The stepwise addition of the components in the prior art of SANDSTROM is obvious, since the coupling agent recited is sulfur-donating compound as well. In fact the prior art of MROCZKOWSKI refers to them as crosslinking agents as well. At the same time the prior art of SANDSTROM teaches that the sulfur donating compounds are mixed together. Finally mineral filler can be utilized either with the rubber blend, which is more probably or with the curative portion. A motivation is in the fact that both disclosures are in the same field of endeavor, which is making of a tire tread.

e) The prior art of JALICS does not teach composition comprising natural rubber and bromobutyl rubber.

With respect to the above argument, the prior art of JALICS was utilized to satisfy the limitation of not only a tire tread, because such is taught by MROCZKOWSKI, but truck tire tread. A motivation of combining MROCZKOWSKI and JALICS is in the fact that both disclosures are in the same field of endeavor, which is making of a tire tread.

f) the prior art of KAUSH does not teach the composition comprising bromobutyl rubber and natural rubber.

Just like in the situation of JALICS, the prior art of KAUSH was utilized to provide for engine mount and not composition, especially since the composition is disclosed in the prior art of MROCZKOWSKI. As first office action indicated both natural rubber and halobutyl rubber can be utilized when making substrate for engine mounts (see col. 7).

Art Unit: 1714

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

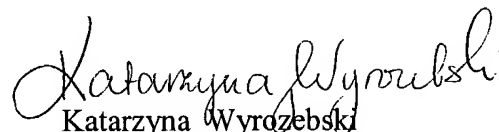
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Katarzyna Wyrozebski
Primary Examiner
Art Unit 1714

May 11, 2004